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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/000,062	11/02/2001	Andrew Ishak	ISHAK-PA-1	9556
7590 04/21/2004			EXAMINER	
ROYAL W. CRAIG LAW OFFICES OF ROYAL W. CRAIG 10 NORTH CALVERT STREET SUITE 153 BALTIMORE, MD 21202			RAIZEN, DEBORAH A	
			ART UNIT	PAPER NUMBER
			2873	

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/000,062	Applicant(s) ISHAK, ANDREW	
	Examiner Deborah A. Raizen	Art Unit 2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-8,10,12,14-17 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1,3,4,6-8,10,12,14-17 and 20-23 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

I. Claims 1, 3, 4, 6, 7, 10, 12, and 14-16, drawn to a sunglass lens that includes two layers of ophthalmic plastic that are colorized with blue-blocking amber tint.

II. Claims 8, 17, and 20-23, drawn to a sunglass lens that includes two layers of ophthalmic plastic that are colorized with color-discriminating grey tint.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. The following is an explanation of the reasons for insisting upon restriction:

Where there is no disclosure of relationship between species (see MPEP § 806.04(b)), they are independent inventions (MPEP 808.01(a)). In the instant case the different species I and II (and the respective tints) are not disclosed or claimed to be usable together. Furthermore, the different species give rise to different spectra. Specifically, ophthalmic plastic layers that are colorized with blue-blocking amber tint are disclosed as usable in a sunglass lens that has the spectrum shown in Figure 4. Ophthalmic plastic layers that are colorized with color-discriminating grey tint are disclosed as usable in a different sunglass lens that has the spectrum shown in Figure 2. As shown in the figures, the spectra are markedly different, with the grey tint (Fig. 2) giving a transmission band that starts at about 415 nm, peaks at about 490 nm, and has a transmission level below 10% above 500 nm. In contrast, the amber tint (Fig. 4) gives a transmission band that starts at about 510 nm, rises to a maximum at about 570 nm, and remains at a constant transmission level of about 10% at longer wavelengths. Furthermore, no combination of the two tints is disclosed as usable together. Therefore, because there is no disclosure of relationship between the two species, they are independent inventions.

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Where the inventions claimed are independent, i.e., where they are not connected in design, operation, or effect under the disclosure of the particular application under consideration (MPEP § 806.04), the facts relied on for this conclusion are in essence the reasons for insisting upon restriction (MPEP 808.01). As explained above, the two species are independent because they are not disclosed as usable together and no other relationship is disclosed between them. Furthermore, they are not connected in design: as explained by Applicant (Remarks, 1/20/04, p. 12, 3<sup>rd</sup> line from the bottom), Applicant specifies a different tint when ordering lens blanks for each species; they are not connected in operation: the different transmission spectra result from the differences in the shapes, spacings, and symmetries of the electronic energy levels of different substances; and they are not connected in effect: as explained above, the spectra are markedly different, and, in turn, the different spectra produce different effects on the wearer, with the amber tint blocking much more blue light and producing more of a color change than the grey tint. These facts, which support the conclusion that the invention claimed are independent, are the reasons for insisting upon restriction.

3. Furthermore, because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

#### ***Response to Arguments***

4. Because the current restriction requirement is similar to the requirement made in the Office Action of 5/29/2003, the examiner responds here to Applicant's arguments in traverse of the requirement.

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5. Applicant's arguments filed 6/19/2003 have been fully considered but they are not persuasive.

Applicant argues that the restriction requirement does not meet the requirements in MPEP Sections 808.02 and 806.05(c). However, the current restriction requirement is informed by MPEP Sections 806.04 and 808.01, which deal with independent inventions, and, more specifically, MPEP Sections 803.02, 806.04(a,d-f,h), 808.01(a), and 809.02, which deal with species. The sections cited in applicant's traversal deal with related inventions and, therefore, do not apply here.

Applicant argues that species I and II are classified together within the same field of search. However, as explained above, a restriction between species is proper if the facts support the conclusion that the inventions are independent. Furthermore, in spite of the same classification, a different search is necessary that presents a serious burden.

Applicant argues that while species I and II are mutually exclusive, they are not patentably distinct because they do not have standalone utility. However, although applicant may traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that the species are obvious variants of one another. Here, applicant has not clearly admitted on the record that the species are obvious variants of one another. Applicant is advised that if the examiner finds one of the inventions unpatentable over the prior

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art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant argues that the concept of color filtration using both amber and grey tint is known and has no standalone novelty. However, each species is not merely directed to the concept of color filtration, but to a multi-layered sunglass lens. Again, while applicant may traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that the species (and not just the concept of color filtration) are obvious variants of one another. Furthermore, each claim, as amended on 1/20/2004, is drawn to only one of the two species. The claims therefore show that Applicant asserts that each species meets all the requirements for patentability, including standalone novelty and standalone non-obviousness, as well as standalone utility.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah A. Raizen whose telephone number is (571) 272-2336. The examiner can normally be reached on Monday-Friday, from 10:00 a.m. to 3:00 p.m. Eastern Standard Time (a part-time schedule).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (571) 272-2328. The fax phone number for the


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organization where this application or proceeding is assigned is (703) 872-9306 (please note that this number is different from the previous two numbers provided until the summer of 2003).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). The Patent EBC is a complete customer service center that supports all Patent e-business products and service applications. External customers should be directed to EBC representatives, who can be reached at **703-305-3028 or toll free at 866-217-9197** between the hours of **6 a.m. and midnight Monday through Friday EST**, or by e-mail at: [ebc@uspto.gov](mailto:ebc@uspto.gov). Additional information is available on the Patent EBC Web site at: <http://www.uspto.gov/ebc/index.html>.

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Scott J. Sugarman  
Primary Examiner